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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,036	12/11/2000	Kenji Yamauchi	249331/98DIV	2508

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EXAMINER

LEUNG, QUYEN PHAN

ART UNIT PAPER NUMBER

2828

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/733,036

Applicant(s)

YAMAUCHI

Examiner

Quyen P. Leung

Art Unit

2828

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-9, 21-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 21-23 and 27-33 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 5-9 and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species II-III (figures 5-7), there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 15.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the positioning-type mark *being a thin line* **and** a measurement type mark located between the active layer and the positioning type mark must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. It is noted that applicant's figures 3-4 show the measurement type mark (17,18) being a thin line, not the positioning-type mark (15,16).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

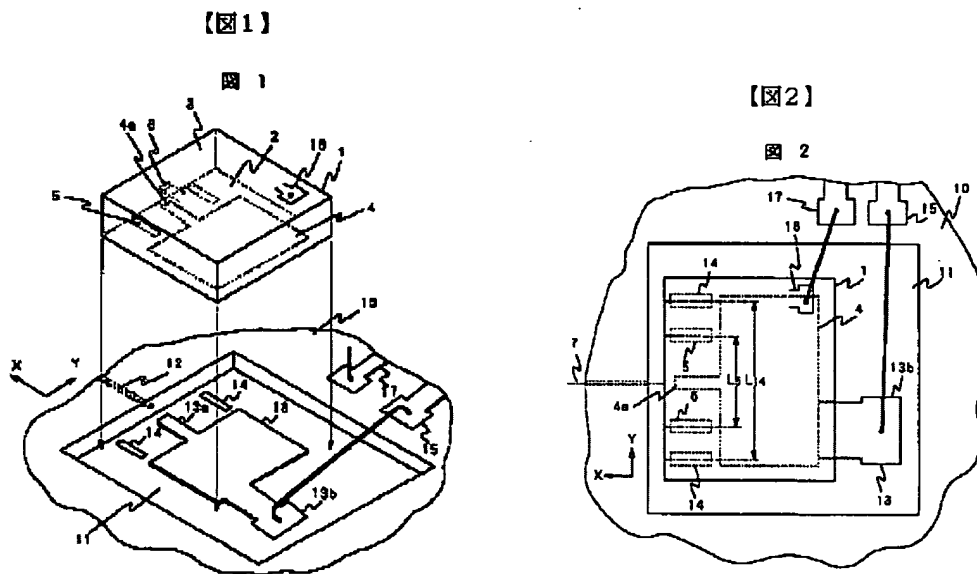
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-3, 21-23, 27-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al (JP 09-145965 A). Sasaki et al discloses the claimed invention. Figure 1 illustrates a semiconductor laser chip comprising a first mark, a second mark.



Also note figure 2 which illustrates a first pair of marks (5) and a second pair of marks (14).

### ***Response to Arguments***

5. Applicant's arguments filed 10/2/02 have been fully considered but they are not persuasive. Applicant made the following arguments:

- a. "A feature of the present invention, in a non-limiting embodiment as defined, for example, by independent claim 1 (and substantially similarly by independent claims 21 and 31), and as shown for example in Fig. 5, is that the first mark (e.g., reference numeral 19; all reference numerals used herein being

solely for the Examiner's understanding and convenience and not for limiting the claims in any way) is constructed by a thin line formed on an upper portion of the active layer 11. With this first mark formed on an upper portion of the active layer 11, shifting amounts of the relative position of the positioning marks 15,16 to an active layer 11 is easily accomplished. Neither Sasaki or Tada teaches or suggests such features."

b. "Accordingly, although a first marker 5 and a second marker 14 are described in Sasaki, neither are formed on an upper portion of a laser output portion 6. Further Applicant notes that Fig. 1 of Sasaki discloses an electrode 4a, which is not a marker. Thus, Sasaki does not teach or suggest "*said first mark is constructed by a thin line formed on an upper portion of said active layer*", as defined by independent claim 1 (and similarly by independent claims 21 and 31)."

c. "Regarding the rejection of claims 1, 6-8, and 29-30 as being anticipated by Tada, fig. 3(c.) of Tada discloses markers..."

In response to arguments a-c above, it is noted that Applicant has proposed that independent claim 1 be rewritten to further include the features of its dependent claim 4, that independent claim 21 include the features of dependent claim 24, and that independent claim 31 include a new feature not previously considered with claim 31 or its dependent claims, that new feature being that of claim 4. So, while applicant's arguments relate to the proposed amended claims, the arguments relating to Tada are moot because Tada was

not depended upon for the rejections of claims 4, 24 at the time the final rejection was made.

In further response to arguments a-b above, Examiner disagrees with Applicant that Sasaki does not teach the claimed features of claims 4 and 24 at the time the final rejection was made, because the claim language as written is broad enough to encompass the other embodiments disclosed by applicant, e.g. figures 3-4 and figures 6-7, as well as the teaching of Sasaki. Applicant's figures 3-4 and 6-7 show a thin-line mark(s) formed on an "upper portion" of the active layer, i.e. not in the same lateral plane as the active layer. Likewise, Sasaki's figures 1 and 2 show thin-line marks (5, 14) not in the same lateral plane as the laser output portion or active layer (6). As noted by applicant's comments above, the claim language is "non-limiting" to figure 5 of applicant's specification. So applicant's argument is not convincing against the Sasaki rejection.

Furthermore, in response to argument b above, Examiner disagrees that Sasaki's element 4a is not a marker, because it is made of the same metal conductive film as Sasaki's other markers 5, 14, and also it "marks" where the projection part of the laser diode (1). So applicant's argument is not found convincing.

***Allowable Subject Matter***

6. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


7. The following is a statement of reasons for the indication of allowable subject matter: The cited prior art do not teach or fairly suggest a semiconductor laser diode chip comprising, along with all the other claimed features, a circular-shaped second pair of marks.

**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quyen P. Leung whose telephone number is (703) 308-0545. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
Quyen P. Leung  
Primary Examiner  
Art Unit 2828

QPL  
May 19, 2003